

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. BERNHARDT

Appeal No. 2000-0787
Application No. 09/017,959

HEARD: January 18, 2001

MAILED

JAN 30 2001

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before CALVERT, STAAB, and NASE, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 16, all the claims in the application.

The disclosed invention is a device to be positioned on a bowler's index finger to enable the bowler to impart spin to a

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bowling ball. The claims on appeal are reproduced in Appendix A of appellant's brief. Claim 1 reads:

1. A bowling accessory, comprising:

a mechanism for retaining the accessory to a bowler's finger;

a pad having one or more projections for contacting a bowling ball, said pad associated with said retaining mechanism, and said pad having an arcuate surface, said projections having desired configuration such that when force is exerted by the bowler on the ball, the projections flatten providing a larger surface on the ball to enhance contact with the ball.

The reference applied in the final rejection is:

Stevens	Des. 97,360	Oct. 29, 1935
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Claims 1 to 16 stand finally rejected on the following grounds:

- (1) Unpatentable for failure to comply with 35 U.S.C. § 112, second paragraph.
- (2) Anticipated by Stevens, under 35 U.S.C. § 102(b).

Rejection (1)

In the final rejection, the examiner refers to the previous Office action (Paper No. 4, Sept. 29, 1998) for the reasons on which this rejection is based. As stated in Paper No. 4, page 2, these reasons are:

Claims 1-16 should be review [sic] as a matter of form such that they only functionally refer to "a bowling ball" since it does not appear to be being claimed in

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combination as a necessary part of the instant invention. For example, note in claim 2 where it recites "the bowling ball" rather than "a bowling ball." In claims 13 and 14, "its axis" is inferential and lacking a clear antecedent.

The criterion for compliance with § 112, second paragraph, is "whether a claim reasonably apprises those of skill in the art of its scope." In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The examiner's first reason, that the bowling ball "does not appear to be being claimed in combination" does not indicate that the claims are indefinite in scope, but only that they are broad. This is not a proper basis for rejecting claims under § 112, second paragraph, because the breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

As for claims 13 and 14, the basis for the asserted indefiniteness of the expression "its axis" no longer exists, since "its axis" was changed to "a longitudinal axis" by the amendment filed Nov. 16, 1998.

Rejection (1) therefore will not be sustained.¹

¹ In reviewing the claims, we note that "one or more projecting for contacting" in claim 2 is unclear, and should be appropriately corrected in any further prosecution.

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Rejection (2)

The test for anticipation is whether a prior art reference discloses every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431, (Fed. Cir. 1997). The law of anticipation does not require that the reference "teach" what appellant teaches; all that is necessary is that the claims "read on" something disclosed in the reference. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Here, we consider that the Stevens patent, which discloses a finger toothbrush, meets these requirements. Considering the reference in relation to the structure recited in claim 1, Stevens discloses a mechanism in the form of a body with a central bore for retaining the device on a wearer's finger, a pad at the bottom of the device (as shown in Figs. 1, 2 and 3) having one or more projections and associated with the retaining mechanism, the pad having an arcuate surface as shown in Fig. 2. As for the recitation in claim 1 of "said projections having desired configuration . . . contact with the ball," the examiner states at page 2 of the final rejection:

While it can be argued that one is not certain of the

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material of the projections in Stevens, it is clear that they are not rigid since they are intended to be used on brushing teeth which would require some degree of softness. It follows that placing force on the projections of any type of brush by an object (such as a bowling ball) would force them to flatten in compressed and/or bent over fashion.

Appellant does not disagree with this statement in his main brief. Rather, he argues that Stevens is nonanalogous art, but it is well settled that "the question whether a reference is analogous art is irrelevant to whether that reference anticipates." In re Schreiber, 128 F.3d at 1477, 44 USPQ2d at 1432. Appellant further argues that "there is no motivation or suggestion in Stevens that it be used as a bowling ball accessory or finger grip as claimed by Applicant" (brief, page 5).

However, this argument is likewise not germane to the issue of anticipation, because it does not concern any differences between the claimed structure and that disclosed by Stevens, but rather the intended use of appellant's device vis-a-vis that of the Stevens device. Such an argument is not persuasive because "[i]t is well settled that the recitation of a new intended use for an old product does not make a claim to that product patentable."

In re Schreiber, 128 F.3d at 1477, 44 USPQ2d at 1431.

For the first time in this appeal, appellant asserts in his reply brief (page 2) that the recited flattening of the

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projections is "neither disclosed nor described in the Stevens reference," and that Stevens fails to describe appellant's claimed invention sufficiently to have placed one of ordinary skill in possession of it, citing In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

As for the first of these arguments, while appellant is correct that Stevens does not expressly disclose or describe that the projections would flatten when force is exerted by the bowler (wearer) on a ball, as recited in claim 1, "a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it." Atlas Powder Co. v. IRECO Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999). The above-quoted statement from page 2 of the final rejection constituted a finding by the examiner that such flattening would inherently occur, a finding which we consider to be reasonable. The burden then shifted to appellant to show that the Stevens structure did not inherently possess the limitation in question, In re Schreiber, 128 F.3d at 1477, 144 USPQ2d at 1432, but he has presented no evidence to that effect.

We disagree with appellant's second argument, since we consider that Stevens would put one of ordinary skill in

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possession of the structure recited in claim 1, which is all that is required for anticipation under § 102(b). In re Spada, supra, which concerned a chemical composition rather than apparatus, does not mandate a contrary conclusion, but rather is consonant with In re Schreiber, supra, in that it holds (911 F.2d at 708, 15 USPQ2d at 1657):

The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from the prior art, can not impart patentability to claims to the known composition.⁴

⁴ All of Spada's claims are composition claims. The issue is not before us of whether Spada may have discovered a new use of a known composition, which use may be patentable as a process. 35 U.S.C. § 101. [citation omitted]

In our view, appellant's statement that "Stevens has no disclosure whatsoever indicating to one skilled in the art that the Stevens reference would meet the elements of Applicant's claims" is not correct. Stevens, being a design patent, does not contain a detailed description of the device shown in its drawings, but that does not vitiate its availability as a reference, since a claimed invention may be anticipated or rendered obvious by a drawing in a reference. In re Meng, 492 F.2d 843, 847, 181 USPQ 94, 97 (CCPA 1974). See also In re Aslanian, 590 F.2d 911, 913, 200 USPQ 500, 502 (CCPA 1979)

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("numerous decisions have indicated that design patents can be properly cited as the basis for an anticipation rejection of claims in an application for a utility patent"). Since, for the reasons discussed above, Stevens expressly or inherently discloses all the limitations of claim 1, we conclude that claim 1 is anticipated by Stevens.

Accordingly, rejection (2) of claim 1, as well as of claims 2 to 5 which appellant has grouped therewith (brief, page 3), will be sustained. Appellant lists claims 6 to 16 as a separate group (*id.*), but they likewise will fall with claim 1, since no explanation is given as to why they are separately patentable. 37 CFR 1.192(c)(7). Moreover, claim 6, the only independent claim of that group, is considered to be anticipated by Stevens for the same reasons as claim 1.

Conclusion

The examiner's decision to reject claims 1 to 16 is reversed as to the rejection under 35 U.S.C. § 112, second paragraph, and affirmed as to the rejection under 35 U.S.C. § 102(b).

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED



IAN A. CALVERT
Administrative Patent Judge



LAWRENCE J. STAAB
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

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